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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/705,586      | 11/10/2003  | Ji Hoon Lee          | SRC-015-U           | 4275             |

7590

10/19/2005

Stephen R. Chapman  
Clemson University  
300 Brackett Hall  
Clemson, SC 29634-5701

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| EXAMINER |
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LEE, SUSANNAH E

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| ART UNIT | PAPER NUMBER |
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1626

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/705,586

Applicant(s)

LEE ET AL.

Examiner

Susannah Lee

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 9-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-13 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Claims 1-13 are pending in the instant application.

#### ***Priority***

This application claims benefit of U.S. Provisional Application No. 60/425,432, filed on 11/12/2002.

#### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-8 drawn to oxylated, diimidazole compound produced from reacting peroxyoxalates with a methylimidazole said oxylated, diimidazole further reacting with hydrogen peroxide to produce an unstable high energy molecule capable of transferring energy to maximize the rate of attaining chemiluminescence in a fluorophore, classified in various subclasses of class 548.
- II. Claim 9 drawn to a high energy, unstable molecule formed from reacting one of the group consisting of OD2MI and OD4MI with hydrogen peroxide.
- III. Claims 10-13 drawn to a method to produce a methyl substituted molecule comprising the steps of: adding a quantity of 2-methylimidazole in an acetate solvent to a quantity of bis(2,4,6 trichlorophenyl)oxylate thereby yielding a methyl substituted oxylate, then reacting said methyl substituted oxylate with a quantity of hydrogen peroxide thereby producing a high energy, unstable molecule, and finally collecting said high energy, unstable molecule for use to provide energy for fluorescence.

Art Unit: 1626

**Where an election of Groups I is made, an election of a single compound is further required** including an exact definition of the oxylated, diimidazole compound. For example, the oxylated, diimidazole compound can be oxalyldi(2-methyl)imidazole. In the instant case, upon election of a single compound, the Office will review the claims and disclosure to determine the scope of the independent invention encompassing the elected compound (compounds which are so similar thereto as to be within the same inventive concept and reduction to practice). The scope of an independent invention will encompass all compounds within the scope of the claim, which fall into the same class and subclass as the elected compound, but may also include additional compounds, which fall in related subclasses. Examination will then proceed on the elected compound AND the entire scope of the invention encompassing the elected compound as defined by common classification. A clear statement of the examined invention, defined by those class(es) and subclass(es) will be set forth in the first action on the merits. Note that the restriction requirement will not be made final until such time as applicant is informed of the full scope of compounds along with (if appropriate) the process of using or making said compound under examination. This will be set forth by reference to specific class(es) and subclass(es) examined. Should applicant traverse on the ground that the compound are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the compound to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other.

All compounds falling outside the class(es) and subclass(es) of the selected compound and any other subclass encompassed by the election above will be directed to nonelected subject

Art Unit: 1626

matter and will be withdrawn from consideration under 35 U.S.C. 121 and 37 C.F.R. 1.142(b). Applicant may reserve the right to file divisional applications on the remaining subject matter. (The provisions of 35 U.S.C. 121 apply with regard to double patenting covering divisional applications.)

Applicant is reminded that upon cancellation of claims to a nonelected invention, the inventions must be amended in compliance with 37 C.F.R. 1.48(b) if one of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 C.F.R. 1.48(b) and by the fee required under 37 C.F.R. 1.17(i).

Markush claims must be provided with support in the disclosure for each member of the Markush group. See MPEP 608.01(p). Applicant should exercise caution in making a selection of a single member for each substituent group on the base molecule to be consistent with the written description.

***Rationale Establishing Patentable Distinctiveness Within Each Group***

Each Group listed above is directed to or involves the use of compounds which are recognized in the art as being distinct from one another because of their diverse chemical structure, their different chemical properties, modes of action, different effects and reactive conditions (MPEP 806.04, MPEP 808.01). Additionally, the level of skill in the art is not such that one invention would be obvious over the other invention (Group), i.e. they are patentable over each other. Chemical structures, which are similar, are presumed to function similarly, whereas chemical structures that are not similar are not presumed to function similarly. The presumption even for similar chemical structures though is not irrebuttable, but may be

Art Unit: 1626

overcome by scientific reasoning or evidence showing that the structure of the prior art would not have been expected to function as the structure of the claimed invention. Note that in accordance with the holding of Application of Papesch, 50 CCPA 1084, 315 F.2d 381, 137 USPQ 43 (CCPA 1963) and In re Lahu, 223 USPQ 1257 (Fed. Cir. 1984), chemical structures are patentably distinct where the structures are either not structurally similar, or the prior art fails to suggest a function of a claimed compound would have been expected from a similar structure.

***The above groups represent general areas wherein the inventions are independent and distinct, each from the other because of the following reasons:***

Inventions I and II are distinct from each other because of the following reasons: the compounds of Groups I and II differ materially in structure and element so much so as to be patentably distinct. In addition, a reference, which anticipates one group may not even render obvious the other.

Inventions I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) that the process for using the product as claimed can be practiced with another materially different product or (2) that the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product as claimed in Group I can be in a materially different process, as shown in Figures 1A and Figure 1B, where different reactants are used to make the products of Invention I.

In addition, because of the plethora of classes and subclasses in each of the Inventions, a serious burden is imposed on the examiner to perform a complete search of the defined areas.

Art Unit: 1626

Therefore, because of the reasons given above, the restriction set forth is proper and not to restrict would impose a serious burden in the examination of this application.

### **Advisory of Rejoinder**

The following is a recitation of M.P.E.P. 821.04, Rejoinder:

Where product and process claims drawn to independent and distinct inventions are presented in the same application, applicant may be called upon under 35 U.S.C. 121 to elect claims to either the product or process. See MPEP § 806.05(f) and § 806.05(h). The claims to the nonelected invention will be withdrawn from further consideration under 37 CFR 1.142. See MPEP § 809.02(c) and § 821 through § 821.03. However, if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims, which depend from or otherwise include all the limitations of the allowable product claim will be rejoined.

Where the application as originally filed discloses the product and the process for making and/or using the product, and only claims directed to the product are presented for examination, when a product claim is found allowable, applicant may present claims directed to the process of making and/or using the patentable product by way of amendment pursuant to 37 CFR 1.121. In view of the rejoinder procedure, and in order to expedite prosecution, applicants are encouraged to present such process claims, preferably as dependent claims, in the application at an early stage of prosecution. Process claims, which depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance. Amendments submitted after final rejection are governed by 37 CFR 1.116. Process claims which do not depend from or otherwise include the limitations of the patentable product will be withdrawn from consideration, via an election by original presentation (see MPEP § 821.03). Amendments submitted after allowance are governed by 37 CFR 1.312. Process claims which depend from or otherwise include all the limitations of an allowed product claim and which meet the requirements of 35 U.S.C. 101, 102, 103, and 112 may be entered.

Where product and process claims are presented in a single application and that application qualifies under the transitional restriction practice pursuant to 37 CFR 1.129(b), applicant may either: (A) elect the invention to be searched and examined and pay the fee set forth in 37 CFR 1.17(s) and have the additional inventions searched and examined under 37 CFR 1.129(b)(2); or (B) elect the invention to be searched and examined and not pay the additional fee (37 CFR 1.129(b)(3)). Where no additional fee is paid, if the elected invention is directed to the product and the claims directed to the product are subsequently found patentable, process claims which either depend from or include all the limitations of the allowable product will be rejoined. If applicant chooses to pay the fees to have the additional inventions searched and examined pursuant to 37 CFR 1.129(b)(2) even if the product is found allowable, applicant would not be entitled to a refund of the fees paid under 37 CFR 1.129(b) by arguing that the process claims could have been rejoined. 37 CFR 1.26(a) states that "[T]he Commissioner may refund any fee paid by mistake or in excess of that required. A change of purpose after the payment of a fee...will not entitle a party to a refund of such fee..." In this case, the fees paid under 37 CFR 1.129(b) were not paid by mistake nor paid in excess, therefore, applicant would not be entitled to a refund. In the event of rejoinder, the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. If the application containing the rejoined claims is not in condition for allowance, the subsequent Office action may be made final, or, if the application was already under final rejection, the next Office action may be an advisory action. Form paragraphs 8.42 through 8.44 should be used to notify applicant of the rejoinder of process claims which depend from or otherwise include all the limitations of an allowable product claim.

In the event of rejoinder, the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104 - 1.106. Thus, to be allowable, the rejoined claims must meet all criteria for

Art Unit: 1626

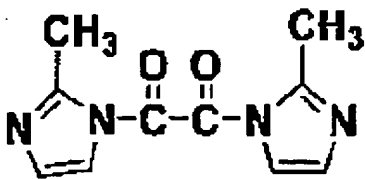
patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. If the application containing the rejoined claims is not in condition for allowance, the subsequent Office action may be made final, or, if the application was already under final rejection, the next Office action may be an advisory action.

The following is a recitation from paragraph five, "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. §103(b)" (1184 TMOG 86(March 26, 1996)):

"However, in the case of an elected product claim, rejoinder will be permitted when a product claim is found allowable and the withdrawn process claim **depends from or otherwise includes all the limitations of an allowed product claim**. Withdrawn process claims not commensurate in scope with an allowed product claim will not be rejoined." (emphasis added)

Therefore, in accordance with M.P.E.P. 821.04 and *In re Ochiai*, 71 F.3d 1565, 37 USPQ 1127 (Fed. Cir. 1995), rejoinder of product claims with process claims commensurate in scope with the allowed product claims will occur following a finding that the product claims are allowable. Until, such time, a restriction between product claims and process claims is deemed proper. Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution to maintain either dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.**

During a telephone conversation with Attorney Stephen Chapman on 09/27/2005 a provisional election was made *without traverse* to prosecute the invention of Group I, comprising Claims 1-8 of an oxylated diimidazole compound. Further, an election of species was made of the compound depicted on page 2 of the fax received on 09/27/05, oxalyldi(2-methyl)imidazole,



Affirmation of this election must be made by applicant in replying to this Office action.



***Scope of the Elected Invention***

The scope of the elected subject matter that will be examined and searched is as follows:

Claims 1-8, compounds drawn to oxylated, diimidazole compound produced from reacting peroxyoxalates with a methylimidazole said oxylated, diimidazole further reacting with hydrogen peroxide to produce an unstable high energy molecule capable of transferring energy to maximize the rate of attaining chemiluminescence in a fluorophore, classified in various subclasses of class 548.

***Scope of Withdrawn Subject Matter***

Claims 9-13 are withdrawn from further consideration by the examiner, 37 C.F.R. §1.142(b), as being drawn to a non-elected invention. The withdrawn subject matter is patentably distinct from the elected subject matter as it differs in structure and element and would require separate search considerations. In addition, a reference, which anticipates one group, would not render obvious the other.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

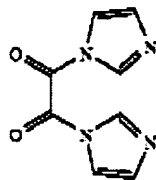
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Nelson, et al (U.S. Pat. No. 5,922,715).

Art Unit: 1626

Applicants claims relate to an oxylated, diimidazole compound of claim 1. Nelson



discloses an oxylated, diimidazole compound, , CAS RN 18637-83-7, 1,1'-(1,2-dioxo-1,2-ethanediyl)bis-1H-imidazole. In addition, this compound is also a well known reagent found in the Aldrich catalog as 1,1'-Oxalyldiimidazole, Aldrich catalog number 18637-83-7 (publication years 2005-2006).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

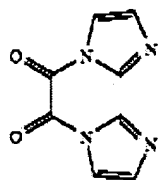
Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Appelblad, et al., "Determination of C-21 Ketosteroids in Serum Using Trifluoromethanesulfonic Acid Catalyzed Precolumn Dansylation and 1,1'-Oxalyldiimidazole Postcolumn Peroxyoxalate Chemiluminescence Detection," *Analytical Chemistry*, Vol. 70, No. 23, December 1, 1998.

Art Unit: 1626

Applicants instant elected invention claims a product by process wherein the product is an oxylated, diimidazole compound, in particular wherein said methylimidazole is 2MimH and 4MimH, used for chemiluminescence detection

Determination of the scope and content of the prior art (MPEP § 2141.01)

Appelblad teaches the use of oxylated, diimidazole compounds of the formula



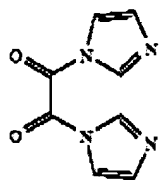
, CAS RN 18637-83-7, 1,1'-(1,2-dioxo-1,2-ethanediyl)bis-1H-imidazole for chemiluminescence detection. (see title and page 5002, column 2, line 30-31.

Ascertainment of the difference between the prior art and the claims (MPEP § 2141.02)

The difference between the prior art of Appelblad and the claims is that in the instant application there are methyl groups off the 2 and 4 position of the imidazole rings, while in Appelblad the imidazole rings are unsubstituted.

Finding of prima facie obviousness – rationale and motivation (MPEP § 2142-2413)

One skilled in the art would have found the claimed compound prima facie obvious because the instantly claimed compound and the compound in Appelblad have the same



diimidazole core structure, . The motivation to make the claimed compounds derives from the expectation that structurally similar compounds would possess similar activity (i.e. pharmacological use). Both the instantly claimed compounds and the compounds of Appelblad are used for chemiluminescence detection. Although, applicant's compound differs in

Art Unit: 1626

that it has a methyl instead of a hydrogen group off the imidazole rings, it is well known in the art that hydrogen and methyl are deemed obvious variants. In re Wood, 199 USPQ 137. In addition, they are used for the same pharmacological use so one skilled in the art would expect the species would have similar properties as the genus.

Therefore since the patentability of a product-by-process claim is determined based on the product itself, not on the process of making it. See In re Thorpe, 227 USPQ 964 (Fed. Cir. 1985). Claims 1-8 are rejected as obvious variants of Appelblad.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 2-5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Claims 2-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The terms "2MimH," "4MimH," and "OD4MI" in claims 2-5 are relative terms which renders the claim indefinite. The terms "2MimH," "4MimH," and "OD4MI" are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the

Art Unit: 1626

scope of the invention. Abbreviations can be utilized in the claim, but should be preceded by the full meaning. For example, DNPO in claim 6 is preceded by the full meaning and is therefore acceptable.

***Telephone Inquiry***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susannah Lee whose telephone number is (571) 272-6098. The examiner can normally be reached on M-F, 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is (571) 272-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Susannah Lee  
Patent Examiner, AU 1626

Date: 10/12/2005

  
JOSEPH K. MCKANE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600